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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/957,471	09/21/2001	Kimihiko Nishioka	P 283651 OL97501N-US	4064
909	7590	10/21/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			LESTER, EVELYN A	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			2873	

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/957,471

Applicant(s)

NISHIOKA ET AL.

Examiner

Evelyn A. Lester

Art Unit

2873

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 5,6,21-26 and 38.  
Claim(s) withdrawn from consideration: 1-4,7-18,20 and 27-37.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheets.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
Evelyn A. Lester  
Primary Examiner  
Art Unit: 2873

***Election/Restrictions***

1. Claims 1-4, 7-18, 20 and 27-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4-27-05.
2. The Applicants comments with respect to the election requirement, provided in their response filed on 10-7-05, have been made of record.
3. This application contains claims 1-4, 7-18, 20 and 27-37 drawn to an invention nonelected with traverse in the response filed on 4-27-05. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Claim Objections***

4. With respect to the objection made to claims 5 and 6, a basis under 35 USC or 37 CFR is not required when the objection is of a minor nature. The objection was made as a courtesy to provide the Applicants an opportunity to explain claim language, which appeared confusing to the Examiner, as opposed to rejecting the claims under 35 USC 112, second paragraph.

Please note that the amendments made to claims 5, and therefore claim 6, were sufficient to overcome the objection. Therefore the objection is withdrawn.

***Response to Arguments***

5. Applicant's arguments filed 10-7-05 have been fully considered but they are not persuasive.

With respect to the Applicants' arguments regarding claims 5 and 6 and the prior art rejection under 35 USC 102(b), wherein the claims are anticipated by Hochstrate (U.S. Patent 4,238,793), the Examiner disagrees that Hochstrate has no disclosure or suggestion that their invention does not achieve "optical deflection." The Examiner maintains that Hochstrate discloses the claimed invention as recited.

The Applicants' appear to presume that the segmented electrodes need to achieve the optical deflection, wherein the claim recites that the "variable-optical-characteristic optical element" is what is "capable of achieving optical deflection." It has been held that the recitation that an element is capable of performing a function is not a positive limitation, but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, Hochstrate's invention need only have the ability to perform the function of optical deflection by the "variable-optical-characteristic optical element," and it does.

It is generally accepted in the optical arts that optical deflection includes various actions, and the Applicants' specification at page 90, lines 8-11, bears this out. Optical deflection includes actions such as reflection, refraction, and diffraction. Hochstrate utilizes reflection in their invention. As noted with respect to Figure 6, Hochstrate discloses the claimed invention of a variable optical characteristic optical element (10) comprising a power source (23) and a drive circuit (including "booster member" 32),

wherein piezoelectric effect is used (note col. 6, lines 1-6). Figure 6 depicts an electro-optical display, wherein element 40 of the device is the display element. The variable-optical-characteristic element includes element 40. Therefore, when the electroluminescent part varies, which need only be on and off to be variable, the display element of the variable-optical-characteristic element has a change in its reflection characteristic, thereby being capable of achieving optical deflection. Therefore, Hochstrate does anticipate claims 5 and 6.

With respect to the Applicants' arguments regarding the prior art rejection of claims 21-26 and 38-39 (claim 39 now cancelled) under 35 USC 102(b), wherein the claims are anticipated by Schachar (U.S. Patent 5,774,274), the Examiner disagrees that Schachar does not disclose the claimed invention.

The claimed invention which is a variable-optical-characteristic optical element having a deformable optical surface which further comprises a control system for driving the variable-optical-characteristic optical element, wherein the control system includes a booster member for creating a voltage necessary for driving the variable-optical-characteristic optical element. Schachar discloses a variable optical characteristic optical element having a deformable optical surface (Figure 9, element 402 (i.e. lens), which has two surfaces which are deformable, col. 9, lines 1-25), and the claimed invention further comprises a control system (equatorial ring of piezoelectric material with electric voltage applied) for driving the variable optical characteristic optical element. The control system includes a "booster member" in element 406, i.e.

solenoids, for creating a voltage necessary for driving. The lens is a varifocal lens element using a fluid. Please note for example Figure 9, and its accompanying text.

The Applicants apparently have misinterpreted Schachar's invention, because the solenoid is an "electric solenoid" (note Schachar at col. 6, lines 33-36). The claimed invention does not recite that the created voltage is applied directly to the variable-optical-characteristic optical element in order to drive it, but does recite that a voltage is necessary for driving the variable-optical-characteristic optical element. Nor does the claimed invention delineate what the "booster member" actually is, and yet the Applicants appear not to have chosen a "means-plus-function" claim language. This means that limitations from the specification cannot be read into the claims. Therefore, Schachar reads on the claimed invention as currently recited, and thereby anticipates the claimed invention of claims 21-26 and 38.


### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evelyn A. Lester whose telephone number is (571) 272-2332. The examiner can normally be reached on subject to an increased flex schedule, M-F, 10-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2873

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Evelyn A. Lester  
Primary Examiner  
Art Unit 2873